

REMARKS

In the Office Action identified above, the Examiner rejected claims 14-16, 19, and 21 under 35 U.S.C. §102(b) as being anticipated by Itami et al. (U.S. Patent No. 5,418,852); and rejected claims 17, 18, 20, 22, and 23 under 35 U.S.C. §103(a) as being unpatentable over Itami et al. and Sako et al. (EP Patent Application No. 0 794 496 A1). Based on the following reasoning, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 102 and § 103(a)¹.

I. The Rejection of Claims 14-16, 19, and 21 Under 35 U.S.C. § 102

Claims 14-16, 19, and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Itami et al. Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 102(b), each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. Itami et al. fails to teach each and every recitation of claims 14-16, 19, and 21.

Claim 14 recites a combination including *inter alia*, "embedding the identification information to a part of said main body of data to which an error correction encoding is

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

performed based on position information” and “embedding the position information to a part of said main body of data to which an error correction encoding is performed.”

Itami et al. fails to disclose at least these claim elements. Itami et al. discloses an unauthorized prevention method for optical disks having a user accessible and a user inaccessible area. (Abstract.) Itami et al. further discloses that “[a]n unlawfully produced optical disk does not have . . . table-of-contents data recorded on the primary defect list areas Bp. Instead of the table-of-contents data, it is possible to record identification (ID) data inherent in each recording medium.” (Col. 13, lines 2024.) Itami et al. discloses that “[t]he ID data is not limited to the above-mentioned ID data. For example, the ID data can be simple flag data.” (Col. 14, lines 50-60.) However, the Examiner has failed to show where Itami et al. teaches “embedding the identification information to a part of said main body of data to which an error correction encoding is performed based on position information” and “embedding the position information to a part of said main body of data to which an error correction encoding is performed,” as recited in claim 14. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claim 14 under 35 U.S.C. § 102(b) as being anticipated by Itami et al.

Further, Applicants note that the newly added elements of claim 14 recite features similar to claim 16 (prior to cancellation) that the Examiner alleged were taught by Itami et al.² Applicants respectfully disagree with the Examiner’s allegations. ,As

² The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

discussed above, the passages of Itami et al. cited by the Examiner disclose that the “ID data can be simple flag data” and that “it is possible to record the ID data on the user accessible area by using an error correction code (ECC) recorded on a sector area accessible in the normal mode.” (Col. 14, lines 50-60). The Examiner has failed to show where Itami et al. teaches “embedding the identification information to a part of said main body of data to which an error correction encoding is performed based on position information” and “embedding the position information to a part of said main body of data to which an error correction encoding is performed,” as recited in claim 14. Accordingly, Applicants submit that contrary to the Examiner’s assertions, Itami et al. fails to teach the features of claim 16 (prior to cancellation) and, therefore, certainly fails to teach the elements of claim 14.

Claims 15 and 19 depend from claim 14. As explained, claim 14 recite elements not disclosed by Itami et al. Accordingly, claims 15 and 19 are allowable over Itami et al. for at least the same reasons as claim 14³. Applicants therefore respectfully request that the rejection of claims 15 and 19 under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Applicants have cancelled claim 16 without prejudice or disclaimer and therefore request the Examiner to withdraw the rejection of claim 16 under 35 U.S.C. § 102(b).

³ As Applicants’ remarks with respect to the base independent claims are sufficient to overcome the Examiner’s rejection of all claims dependent therefrom, Applicants’ silence as to the Examiner’s assertions with respect to dependent claims is not a concession by Applicants to the Examiner’s assertions as to these claims, and Applicants reserve the right to analyze and dispute such assertions in the future.

Claim 21, although of different scope, recites elements similar to that discussed above with regard to claim 14. Applicants therefore request the Examiner to withdraw the rejection of claim 21 for at least the same reasons discussed above with respect to claim 14.

II. The Rejection of Claims 17, 18, 20, 22, and 23 Under 35 U.S.C. § 103).

Claims 17, 18, 20, 22, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Itami et al. and Sako et al. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Claims 17, 18, and 20 depend from claim 14, and thus require all the elements of claim 14. As explained above, claim 14 is allowable over Itami et al. Accordingly, claims 17, 18, and 20 are also allowable over this reference for at least the same reasons set forth for claim 14.

Moreover Sako et al. does not make up for the deficiencies of Itami et al. That is, the Examiner has also failed to show where Sako et al. teaches or suggests at least

“embedding the identification information to a part of said main body of data to which an error correction encoding is performed based on position information” and “embedding the position information to a part of said main body of data to which an error correction encoding is performed,” as recited in claim 14. Indeed, the Examiner only cited Sako et al. for its alleged teaching of “said identification information has a plurality of partial identification information.” (OA at 5.) Accordingly, since the cited references, taken either alone or in any reasonable combination, fail to teach each and every element required by claims 17, 18, and 20, no prima facie case of obviousness has been made out with respect to these claims. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 17, 18, and 20 under 35 U.S.C. § 103 as being obvious from Itami et al. and Sako et al.

Claim 22 although of different scope, recites elements similar to that discussed above with regard to claim 14. Applicants therefore request the Examiner to withdraw the rejection of claim 22 for at least the same reasons discussed above with respect to claim 14. Moreover, as explained above, Sako et al. does not make up for the deficiencies of Itami et al. Indeed, the Examiner cited Sako et al. only for its alleged teaching of “encrypting digital data including digital contents by using said identification.” (OA at 7.). Accordingly, Applicants submit that claim 22 is allowable over Itami et al. and Sako et al.

Claim 23 depends from claim 22, and thus requires all the elements of claim 22. As explained above, claim 22 is allowable over Itami et al. and Sako et al. Accordingly, claim 23 is also allowable over these references for at least the same reasons set forth for claim 22.

III. Conclusion

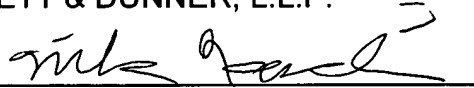
In view of the foregoing remarks, Applicants submit that this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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